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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,636	12/13/2001	Martin Reif	IN-12101	5951

7590

02/25/2003

Basf Corporation
Patent Department
1419 Biddle Avenue
Wyandotte, MI 48192-3736

EXAMINER

ZUCKER, PAUL A

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 02/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

10/018,636

Applicant(s)

REIF ET AL.

Examiner

Paul A. Zucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Current Status

1. This action is responsive to Applicants' amendment of 16 December 2002 in Paper No 6.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Applicant's cancellation of claims 7 and 20-24 is acknowledged.
4. Claims 1-6 and 10-19 remain pending.
5. The objection to the specification set forth in paragraph 2 of the previous Office Action in Paper No 5 is withdrawn in response to Applicant's remarks.
6. The rejection under 35 U.S.C. 102(b) set forth in paragraph 3 of the previous Office Action in Paper No 5 is withdrawn as moot in view of Applicants' cancellation of all relevant claims.
7. Claims 1-6 and 10-19 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al (US 4,193,932 03-1980). For the purposes of this rejection, the limitation "a positive amount", which is not defined in the specification, is considered to mean "a non-negative amount" which is met by a value of zero. Yamamoto discloses (Column 4, line 46 – column 5, line 5) a process for the reaction of diaminodiphenylmethane with phosgene to give isocyanate. Yamamoto discloses (Column 4, lines 48-56) a two stage process for the reaction of diaminodiphenylmethane with phosgene in chlorobenzene (an inert solvent), reacting with an excess of phosgene below 20 °C and again at 150 °C at atmospheric pressure (presumed). Yamamoto is silent with regard to the bromine

content of the phosgene employed and so no bromine is considered to be present.

Yamamoto thus anticipates instant claims 1-6 and 10-19.

Examiner's Response to Applicants' Remarks with Regard to This Rejection

8. Applicants argue that the rejection under 35 U.S.C. 102(b) does not apply to Applicants' amended claims because Applicants' claims require "a positive amount" of bromine or iodine. As indicated above, the meaning of "a positive amount" is unclear and is not defined in the specification. Applicants' implied meaning that "a positive amount" means "a non-zero amount" of bromine or iodine does not have support in the specification. It is clear that Applicants contemplate (Specification, page 11, lines 20-26) the use of "bromine-free and iodine-free-phosgene".

Applicant's arguments filed 16 December 2002 have been fully considered but they are not persuasive for the reasons discussed above.

New Rejections and Objections

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1-6 and 10-19 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 2 recite the limitation "a positive amount". This limitation has two possible interpretations:

- a. "a non-negative amount", or
- b. "a non-zero amount".

It is impossible to determine the intended scope of Applicants' claims because the limitation "a positive amount" is not defined in the specification. Claims 1 and 2, and their dependents, are therefore rendered in definite.

Specification

10. The specification is finally objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Amended claims 1 and 2 recite the limitation "a positive amount". This terminology lacks antecedent basis in the specification. Applicants are therefore required to remove this terminology from the claims.

Conclusion

11. Claims 1-6 and 10-19 are pending. Claims 1-6 and 10-19 are rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 703-306-0512. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 703-308-4532. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Paul A. Zucker
Patent Examiner
Technology Center 1600

February 20, 2003

A handwritten signature in black ink, appearing to read "Johann Richter", with a long horizontal flourish extending to the right.

Johann Richter, Ph.D., Esq.
Supervisory Patent Examiner
Technology Center 1600